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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/433,360	11/03/1999	Hamiduddin Khoja	1544.003	2446

27476 7590 08/28/2002

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EXAMINER

MURPHY, JOSEPH F

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 08/28/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/433,360

Applicant(s)

KHOJA ET AL.

Examiner

Joseph F Murphy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Sequence Comparison A, B, C.

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group III, claims 6-13 in Paper No. 14, 8/14/2002 is acknowledged. The traversal is on the ground(s) that there is no burden on the Examiner to search claims 1-20 together (Paper No. 14 at 1). This is not found persuasive for the following reasons. Applicant's attention is directed to MPEP 808.02 which states that "Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05 (c-i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) Separate classification thereof; (B) A separate status in the art when they are classifiable together; (C) A different field of search." As set forth in the Restriction requirement (Paper No. 13, 6/26/2002), the separate classification established for each Group demonstrates that each distinct Group has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Thus, the Restriction requirement is proper.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC §§ 101, 112, first paragraph***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 6-13 are rejected under 35 U.S.C. § 101 because they are drawn to an invention with no apparent or disclosed patentable utility. The instant application has provided a description of an isolated DNA encoding a protein and the protein encoded thereby. The instant application does not disclose the biological role of this protein or its significance. The claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility. Novel biological molecules lack well-established utility and must undergo extensive experimentation. Applicant is directed to the Utility Examination Guidelines, Federal Register, Vol. 66, No. 4, pages 1092-1099, Friday January 5, 2001.

It is clear from the instant specification that the nucleic acid encoding the VSHK-1 polypeptide has been assigned a function because of its similarity to known proteins (Specification at 18, line 11). However, it is commonly known in the art that sequence-to-function methods of assigning protein function are prone to errors (Doerks et al.1998). These errors can be due to sequence similarity of the query region to a region of the alleged similar protein that is not the active site, as well as homologs that did not have the same catalytic activity because active site residues of the characterized family were not conserved (Doerks et al. page 248, column 3, fourth and fifth paragraphs). Inaccurate use of sequence-to-function methods have led to significant function-annotation errors in the sequence databases (Doerks et al. page 250, column 1, third paragraph). Furthermore, Brenner (1999, Trends in Genetics 15:132-133) argues that accurate inference of function from homology must be a difficult problem since, assuming there are only about 1000 major gene superfamilies in nature, then most homologs must have different molecular and cellular functions. Finally, Bork et al. (1996, Trends in Genetics 12:425-427) add that the software robots that assign functions to new proteins often

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assign a function to a whole new protein based on structural similarity of a small domain of the new protein to a small domain of a known protein. Such questionable interpretations are written into the sequence database and are then considered facts.

Additionally, even if, *arguendo*, the nucleic acid encoding the VSHK-1 protein is found to be a G-protein coupled receptor, it is an orphan receptor. Since the ligand to this receptor is unknown, the function of the protein is also unknown. Neither the specification nor the art of record disclose any diseases or conditions associated with the function or expression of the VSHK-1 protein, therefore, there is no "real world" context of use. Further research to identify or reasonably confirm a "real world" context of use is required. In the instant case, the fact that the claimed invention encodes a GPCR is not sufficient to establish a specific and substantial utility. Although GPCRs have been found to be involved in many different processes and have been the target of much research and drug discovery, unless the specific ligand for each receptor is known, unless the biological activity of the receptor is disclosed and unless the processes that each receptor is involved in are identified, the receptor has no "real world" use, and therefore, lacks specific and substantial utility.

The specification asserts several allegedly patentable utilities for the claimed nucleic acid encoding VSHK-1 polynucleotide. The Specification asserts that the nucleic acid of the instant application can be used in diagnostic assays to detect VSHK-1 polypeptide or mRNA expression in a biological sample (Specification at 42). However, this asserted utility is credible and substantial but not specific. Hybridization probes can be designed from any polynucleotide sequence. Further, the specification does not disclose specific cDNA or DNA targets.

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The specification further asserts that the nucleic acid of the instant application can be used in screening assays to identify agents which modulate VSHK-1 receptor signal activity, VSHK-1 ligands, or levels of mRNA encoding VSHK-1 (Specification at 46). However, this asserted utility is credible but not specific or substantial. Such assays can be performed with any polynucleotide. Nothing is disclosed about how the polynucleotide is affected by the compounds, which in turn affect production of mRNA and polypeptide. Additionally, the specification discloses nothing specific or substantial for the mRNA and polypeptide produced in this method. Since this asserted utility is also not present in mature form, so that it could be readily used in a real world sense, the asserted utility is not substantial.

The specification further asserts that the nucleic acid of the instant application can be used to treat certain diseases with compositions which modulates VSHK-1 receptor signal activity, VSHK-1 ligands, or levels of mRNA encoding VSHK-1 (Specification at 55). However, this asserted utility is specific but not substantial or credible. The specification does not disclose diseases associated with altered VSHK-1 activity. Significant further experimentation would be required of the skilled artisan to identify individuals with such a disease. There is no disclosure, for example, of whether the compounds could be administered orally or parentally, dosages, how to assay for improvement or intolerable levels of side effects, etc. Since this asserted utility is also not present in mature form, so that it could be readily used in a real world sense, the asserted utility is not substantial.

After complete characterization, this protein may be found to have a patentable utility. This further characterization, however, is part of the act of invention and until it has been undertaken Applicant's claimed invention is incomplete. The instant situation is directly

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analogous to that which was addressed in *Brenner v. Manson*, 148 USPQ 689 (Sup. Ct., 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anticancer activity was alleged to be potentially useful as an antitumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 USC § 101, which requires that an invention must have either an immediately obvious or fully disclosed "real world" utility. The court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion."

The instant claims are drawn to a nucleic acid encoding a polypeptide which has an as yet undetermined function or biological significance. Until some actual and specific significance can be attributed to the protein identified in the specification as VSHK-1, the instant invention is incomplete. The polypeptide encoded by the nucleic acids of the instant invention is known to be structurally analogous to proteins that are known in the art as G protein coupled receptors. In the absence of knowledge of the natural substrate or biological significance of this protein, there is no immediately obvious patentable use for it. To employ a protein of the instant invention in the identification of substances which inhibit its activity is clearly to use it as the object of further research which has been determined by the courts to be a non-patentable utility. Since

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the instant specification does not disclose a "real world" use for VSHK-1 then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 USC § 101 as being useful.

Claims 6-13 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Even if, *arguendo*, the nucleic acid of the instant invention is found to have a patentable utility, claims 6-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid encoding an amino acid of SEQ ID NO: 2, or a nucleic acid with the sequence as set forth in SEQ ID NO: 1, does not reasonably provide enablement for a nucleic acid encoding an amino acid which is a fragment of at least 8 amino acids of SEQ ID NO: 2, or a nucleic acid which is 70% identical to SEQ ID NO: 1, or a nucleic acid which comprises at least 18 contiguous nucleotides of SEQ ID NO: 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 6-13 are overly broad since insufficient guidance is provided as to which of the myriad of variant nucleic acids encode polypeptides which will retain the characteristics of VSHK-1. Applicants do not disclose any actual or prophetic examples on expected performance parameters of any of the possible muteins of VSHK-1. It is known in the art that even single amino acid changes or differences in the amino acid sequence of a protein can have dramatic effects on the protein's function. It is also known in the art that a single amino acid change in a

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protein's sequence can drastically affect the structure of the protein and the architecture of an entire cell. For example, Voet et al. (1990) teaches that a single Glu to Val substitution in the beta subunit of hemoglobin causes the hemoglobin molecules to associate with one another in such a manner that, in homozygous individuals, erythrocytes are altered from their normal discoid shape and assume the sickle shape characteristic of sickle-cell anemia, causing hemolytic anemia and blood flow blockages (pages 126-128, section 6-3A and page 230, column 2, first paragraph).

Since the claims encompass variant nucleic acids and given the art recognized unpredictability of the effect of mutations on protein function, it would require undue experimentation to make and use the claimed invention. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. The factors considered to be relevant in the instant case are set forth below:

(1) the breadth of the claims - The claims are drawn to a nucleic acid encoding an amino acid which is a fragment of at least 8 amino acids of SEQ ID NO: 2, or a nucleic acid which is 70% identical to SEQ ID NO: 1, or a nucleic acid which comprises at least 18 contiguous nucleotides of SEQ ID NO: 1.

(2) the nature of the invention - The instant invention is a a nucleic acid encoding an amino acid which is a fragment of at least 8 amino acids of SEQ ID NO: 2, or a nucleic acid which is 70% identical to SEQ ID NO: 1, or a nucleic acid which comprises at least 18 contiguous nucleotides of SEQ ID NO: 1.

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(3) the state of the prior art - The Voet reference demonstrates that even single amino acid changes or differences in the amino acid sequence of a protein can have dramatic effects on the protein's function.

(5) the level of predictability in the art - The Voet reference demonstrates the unpredictability of the protein art.

(6) the amount of direction provided by the inventor - Applicant has only taught a nucleic acid with a sequence as set forth in SEQ ID NO: 1, and the polypeptide of SEQ ID NO: 2.

(7) the existence of working examples - Working examples are not provided for VSHK-1.

(8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. Given the breadth of claims 6-13 in light of the predictability of the art as determined by the number of working examples, the level of skill of the artisan, and the guidance provided in the instant specification and the prior art of record, it would require undue experimentation for one of ordinary skill in the art to make and use the claimed invention.

Claims 6-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.

These are genus claims. The claims are drawn to a nucleic acid encoding an amino acid which is a fragment of at least 8 amino acids of SEQ ID NO: 2, or a nucleic acid which is 70% identical to SEQ ID NO: 1, or a nucleic acid which comprises at least 18 contiguous nucleotides of SEQ ID NO: 1. The specification and claim do not indicate what distinguishing attributes shared by the members of the genus. The specification and claim do not place any limit on the number of amino acid substitutions, deletions, insertions and/or additions that may be made to the encoded SEQ ID NO: 2. Thus, the scope of the claim includes numerous structural variants, and the genus is highly variant because a significant number of structural differences between genus members is permitted. The specification and claim do not provide any guidance as to what changes should be made. Structural features that could distinguish compounds in the genus from others in the protein class are missing from the disclosure. No common structural attributes identify the members of the genus. The general knowledge and level of skill in the art do not supplement the omitted description because specific, not general, guidance is what is needed. Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, and because the genus is highly variant, a nucleic acid with a sequence as set forth in SEQ ID NO: 1, and the polypeptide of SEQ ID NO: 2 is insufficient to describe the genus. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus. Thus, applicant was not in possession of the claimed genus.

***Claim Rejections - 35 USC § 112 second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the term "stringent conditions", which is a conditional term and renders the claim indefinite. Furthermore, some nucleic acids which might hybridize under conditions of moderate stringency, for example, would fail to hybridize under conditions of high stringency. The metes and bounds of the claim thus cannot be ascertained. This rejection could be obviated by supplying specific conditions supported by the specification which Applicant considers to be "stringent".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 6-13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,932,445 (Lal et al.). U.S. Patent No. 5,932,445 has a priority date of 11/7/1997.

U.S. Patent No. 5,932,445 discloses the cloning and expression of a nucleic acid which encodes an SP-16 polypeptide (column 4, lines 28-31). The nucleic acid encoding SP-16 is 83.6% identical to SEQ ID NO: 1 of the instant application (see Sequence Comparison A, attached) and has at least 70% sequence identity to nucleotides 1-324 and 652-1890 of the sequence set forth in SEQ ID NO: 1, thus claim 8 is anticipated. The nucleic acid encoding the SP-16 polypeptide would hybridize to SEQ ID NO: 1, thus claim 9 is anticipated. U.S. Patent No. 5,932,445 discloses vectors and host cells comprising the nucleic acid encoding SP-16 (column 4, 42-46) thus claims 10-13 are anticipated. The encoded SP-16 polypeptide is 100% identical, and comprises at least 8 contiguous amino acids, of the polypeptide sequence as set forth in amino acids 1-80 and 189-350 of SEQ ID NO: 2 (see Sequence Comparison B, attached), thus the nucleic acid encoding SP-16 anticipates claims 6-7.

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Claims 6-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuoka et al. (1993).

Matsuoka et al. teaches the cloning of a nucleic acid which encodes a polypeptide (Matsuoka at 508, Figure 2). The encoded polypeptide is 89.1% identical, and comprises at least 8 contiguous amino acids, of the polypeptide sequence as set forth in amino acids 1-80 and 189-350 of SEQ ID NO: 2 (see Sequence Comparison C, attached), thus the nucleic acid encoding the polypeptide of Matsuoka et al. (PPR1) anticipates claims 6-7. The nucleic acid encoding the PPR1 polypeptide has at least 70% sequence identity to nucleotides 1-324 and 652-1890 of the sequence set forth in SEQ ID NO: 1, thus claim 8 is anticipated. The nucleic acid encoding the PPR1 polypeptide would hybridize to SEQ ID NO: 1, thus claim 9 is anticipated. Matsuoka et al. teaches vectors and host cells comprising the nucleic acid encoding PPR1 (Matsuoka at 505) thus claims 10-13 are anticipated.

### ***Conclusion***


No claim is allowed.

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
August 21, 2002